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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,186	12/08/2000	Donald L. Schilling	GBTI95US	6858

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EXAMINER
PATEL, AJIT

ART UNIT	PAPER NUMBER
2664	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,186

Applicant(s)

SCHILLING, DONALD L.

Examiner

AJIT G. PATEL

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,18-22,24-27 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,18-22,24-27 and 29-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2664

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 16,18-22,24-27,29-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S.

Patent No. 5,862,133. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are broader than the patented claims.

The following is the comparison,

Regarding claims 16,22,27,32,38, a method, using a receiver, comprising the step of : processing a header in a spread-spectrum signal, to generate a reference signal, the processing of the header comprising (see 5,862,133 at col. 12, lines 59-60, lines 65-68; col. 13, lines 1-3); detecting, at a processing frequency, the header in the spread-spectrum signal (see 5,862,133, col. Col. 12, line 68; col. 13, line 1); outputting, responsive to detecting the header, a header-detection signal (see 5,862,133, col. 13, lines 2-3); generating, responsive to the header-detection signal, control and timing signals (see 5,862,133, col. 13, lines 4-6); disspreading a multichannel-spread-spectrum signal embedded in the spread-spectrum signal as a plurality of received spread-

spectrum channels, respectively (see 5,862,133 , col. 13, lines 9-13); and multiplexing data obtained from the plurality of received spread-spectrum channels as received data (see 5,862,133 , col. 13, lines 14-16).

Regarding claim 18, 24,29, the step of storing the received data (see 5,862,133, col. 13, lines 19-21).

Regarding claim 19,25,30,36, the step of decoding the received data (see 5,862,133, col.13, lines 17-18).

Regarding claim 20,26,31,37, the step of translating the spread-spectrum signal from a carrier frequency to a processing frequency (see 5,862,133, col.12, lines 61-64).

Regarding claim 21, the step of generating, responsive to the reference signal, control and timing signals (see 5,862,133, col. 13, lines 5-6).

Regarding claim 33, the common chip sequence signal is further common with respect to a plurality of users (see 5,862,133, col. 13, lines 23-24).

Regarding claim 35, the header is followed in time by the multichannel-spread-spectrum signal, in the received spread-spectrum signal (see 5,862,133, col. 13, lines 4-6).

Regarding claim 39, the means for processing the header comprises header-detection means and a processor responsive to the header-detection means for generating the control or timing signal (see 5,862,133,col. 13, lines 4-6, col. 13, lines 4-6).

Regarding claim 40, the header-detection means comprises a header-matched filter (see 5,862,133, col. 12, line 65).

Regarding claim 41, the despreader comprises a plurality of data matched filters, each of the data matched filters performing processing with a different one of the respective chip sequence signals (see 5,862,133, col.13, lines 7-10).

Regarding claim 34, the header processor provides the timing signal. However, it would have been obvious to one skilled in the art to use timing signal for synchronization purpose.

For claims 16,18-22,24-27,29-41, Applicant merely broaden the scope of the patent 5,862,133 claims 1-6 by eliminating the limitations.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. APP. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

3. Claims 16,18-22,24-27,29-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28,39-44,55-61 of U.S. Patent No. 6,262,971. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are broader than the patented claims.

The following is the comparison,

Header-detection means ---timing signals in claim 22 is the same as header detection means --signal in claim 28; receiver-spread-spectrum means --- channels in

claim 22 is the same as receiver-spread-spectrum means ---channels in claim 28; multiplexing means ---data output in claim 28 is the same as multiplexing means ---received data in claim 28. Similar comparison can be made with remaining claims.

For claims 16,18-22,24-27,29-41, Applicant merely broaden the scope of the patent 6,262,971 claims 28,39-44,55-61 by eliminating the limitations.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. APP. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

4. Claims 16, 22, 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, it is not clear whether a reference signal recited in line 2 is the same as control and timing signals recited in line 6. Same error appears in claims 22, 27.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJIT G. PATEL whose telephone number is 571-272-3140. The examiner can normally be reached on MONDAY-THURSDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AP


Ajit Patel
Primary Examiner